IN THE

Supreme Court of the United States

OCTOBER TERM, 1978

No. 79-136

LUTRELLE F. PARKER, Acting Commissioner of Patents and Trademarks, *Petitioner,*

vs.

MALCOLM E. BERGY, et al., *Respondents.*

LUTRELLE F. PARKER, Acting Commissioner of Patents and Trademarks, *Petitioner,*

vs.

ANANDA M. CHAKRABARTY, *Respondent.*

BRIEF FOR RESPONDENTS MALCOLM E. BERGY, ET AL., IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

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Respondents, Malcolm E. Bergy et al., oppose the petition for writ of certiorari to the United States Court of Customs and Patent Appeals.

QUESTION PRESENTED

Petitioner's statement of the question presented for review should be replaced by the statement of the issue

made by the Court below. The Court below recognized the issue as

> "... Is a man-made, biologically-pure culture of a microorganism, for industrial use in manufacturing an antibiotic, whose properties were discovered by the applicant for patent, excluded from the terms 'manufacture' and 'composition of matter' in 35 USC 101 because the microorganism is alive?" (P.[1] App. A 45a).

The Court below found that the Petitioner's statement

> "... is overly broad, which is calculated to magnify its importance. We are not dealing with all living things, including man, fruits, vegetables, and flowers—all 'organisms.' ... To give a homely simple analogy, it is like asking whether a yeastcake or dried yeast powder is a 'manufacture' or 'composition of matter'. Yeast is alive." (P. App. A 45a).

STATUTE INVOLVED

The only statute involved in rejecting the claimed subject matter as nonstatutory is 45 U.S.C. § 101 (P. 3).

Reference in the Petition to the Plant Patent Act of 1930 (P. 3) is misleading because the application for the invention of the present case was *not* filed in the United States Patent and Trademark Office under said Act.

STATEMENT OF THE CASE

This case concerns a man-made biologically pure culture of a novel microorganism. A patent application

[1] "P." refers to the Petition for Writ of Certiorari to the United States Court of Customs and Patent Appeals filed in the present case.

was filed by the respondents in the United States Patent and Trademark Office on June 10, 1974. The invention is claimed in the patent application by two types of claims. The first type of claim is a *process* claim using the biologically pure culture of the novel microorganism to make the useful antibiotic lincomycin. The second type of claim is directed to the biologically pure culture of the novel microorganism itself. The Patent Examiner allowed the process claims,[2] but rejected the claim to the biologically pure culture of the novel microorganism under 35 U.S.C. § 101.[3] On appeal, this rejection was affirmed by the United States Patent and Trademark Office Board of Appeals. The decision by the Board of Appeals was reversed by the United States Court of Customs and Patent Appeals in a decision handed down on October 6, 1977. *In re Bergy et al.*, 563 F.2d 1031 (1977).

On June 26, 1978, this Court granted a petition for a writ of certiorari filed by the Solicitor General seeking review of the Court of Customs and Patent Appeals' decision, vacated the judgment and remanded the case to the Court of Customs and Patent Appeals "for further consideration in light of *Parker* v. *Flook*, 437 U.S. 584" (438 U.S. 902).

The Court of Customs and Patent Appeals reaffirmed its initial decision. *In re Bergy et al.*, 596 F.2d 952

[2] Four process claims were allowed. Similar process claims are found in hundreds of U.S. patents relating to the production of antibiotics.

[3] Both the allowed claims and the rejected claim recite a living microorganism. This living microorganism is the *same* in both instances, and it is characterized by a single disclosure in the patent application covering twelve (12) pages of the record filed in the United States Court of Customs and Patent Appeals (R. 8-19).

(1979). However, this time, the majority consisted of four judges, with one dissent, as compared to the initial 3-2 decision. (P. App. A 1a-70a). The majority discussed *Parker* v. *Flook, supra,* as follows:

> "*Flook* was concerned only with the question of what is a 'process' under § 101, in the context of computer program protection. No such issue is presented in either of these appeals.
>
> "There is no better authority on what the Supreme Court has decided in a case than the Court itself and we are fortunate to have its own summary of what it decided in *Flook*. It appears at the end of footnote 18, 437 U.S. at 595, as follows:
>
> > 'Very simply, our holding today is that a claim for an improved method of calculation, even when tied to a specific end use, is unpatentable subject matter under § 101.'
>
> "We do not venture to elaborate. The appeals here involve no method of calculation, and the *Flook holding* appears to have no bearing.
>
> "As indicated earlier, we deem it our duty to seek whatever additional light there may be in the Court's opinion on the meaning of § 101, without restricting ourselves to the holding. It is stated to be well established in patent law that the following are not within the statutory categories of subject matter enumerated in § 101 and its predecessor statutes as interpreted through the years: principles, laws of nature, mental processes, intellectual concepts, ideas, natural phenomena, mathematical formulae, methods of calculation, fundamental truths, original causes, motives, the Pythagorean theorem, and the computer-implementable method claims of Benson and Tabbot. The present appeals do not involve an attempt to patent any of these things and the Court's review of this hornbook law is, therefore, inapplicable to the issue before us, which involves only the construction of the terms 'manufacture, or composition matter'." (P. App. A 22a).

The majority analyzed the holding in *Deepsouth Packing Co.* v. *Laitram Corp.,* 406 U.S. 518 (1972), which was cited in *Flook,* and compared it with the facts of the subject case. (P. App. A 24a-25a). A clear distinction was found.

> ". . . The respondent in *Deepsouth* was asking the Court to expand established patent rights territorially, or to treat making parts of a machine as making the machine, by modifying prior cases construing the patent statutes. The Court refused, producing the quoted passage [P. App. A 25a] in the process.
>
> "We do not find the quoted passage to have any bearing on our problem. We are not faced with a litigant urging upon us a construction of § 101 which is at odds with established precedent. Rather, we deal with a case of first impression. Not having been asked to make a change in existing law or to overrule or modify any case or to expand any right given by Congress, we need in this case no signal from that body." (P. App. A 25a).

Thus, the majority stated:

> "To conclude on the light *Flook* sheds on these cases, very simply, for the reasons we have stated, we find none." (P. App. A 26a).

ARGUMENT

The Respondents respectfully submit that this case does *not* merit the granting of a writ of certiorari, because the decision by the United States Court of

Customs and Patent Appeals (hereinafter referred to as *Bergy*)

(1) is *not* in conflict with any decision of another court on the same issue;

(2) does *not* extend the patent laws; and,

(3) is *not* inconsistent with the principles of construction of the patent law recently restated in *Parker* v. *Flook*, 437 U.S. 584 (1978).

In summary, there are *no special* and *important* reasons for granting a writ of certiorari in this case.

Bergy Is *Not* In Conflict With Any Other Decision

Since the subject case is one of first impression in the courts, "there is no prior precedent to be extended or overruled, —." (P. App. A 64a). Accordingly, the writ of certiorari is not necessary to resolve a conflict of decisions among the courts.

Bergy Does *Not* Extend The Patent Laws

Though the issue of this case was previously not before a court, it is a fact that it has been before the United States Patent and Trademark Office (PTO) for a long time. (P. App. A 64a-67a). Many patents have been issued by the PTO with claims drawn to, for example, (a) a composition containing oil and *Bacillus thuringiensis* (which is a "living microorganism"), (b) dry baker's viable yeasts (also a "living microorganism"), etc. (P. App. A 66a). In view of this history of the PTO issuing patents claiming living microorganisms, the argument that *Bergy* extends the patent law is unavailable as support for the granting

of a writ of certiorari. As succinctly stated by the majority in *Bergy*

> "It is not possible to reconcile the assertion that we are 'expanding' patent law to cover living things with the PTO's issuance of the foregoing patents. Neither is it possible to reconcile the contention with the performance of the PTO in the very case before us." (P. App. A 67a).

Bergy Is *Not* Inconsistent With Accepted Principles of Construction of The Patent Law

As evidenced by its thorough and scholarly opinion, the *Bergy* majority was very careful in considering the facts of this case in the light of *Flook*. It is inconceivable that the majority opinion can now be questioned as being inconsistent with *Flook* (P. 11), or that it "rejected the principles of construction of the patent law recently restated" in *Flook* (P. 8). The *Bergy* majority carefully distinguished *Flook* from the *Bergy* facts. (P. App. A 20a-26a). Their incisive analysis meets the highest test of legal review; it merits support, not criticism.

In addition to distinguishing *Flook* from *Bergy*, the *Bergy* majority expertly detailed the "Anatomy of the Patent Statute" to place the entire matter of interpreting the Patent Statute in its proper perspective. (P. App. A 10a-20a). Again, this is further evidence of the *Bergy* majority's exercise of the highest degree of care in deciding *Bergy*.

Since the argument of the pertinency of the Plant Patent Act to *Bergy* facts was advanced by the PTO, the *Bergy* majority carefully and exhaustively ana-

lyzed and laid to rest this untenable position. (P. App. A 49a-64a). As the *Bergy* majority stated:

> "The principal mistake of the PTO was to look to the legislative history of the Plant Patent Act for evidence of the intent of a *previous* Congress, saying, in effect, that if Congress in 1930 passed an act extending patent protection to plant breeders, then Congress in 1874 must not have intended that 'manufactures' and 'compositions of matter' in R.S. § 4886 include *any* living organism. The violence done by this analysis resides in ascribing to a preceding Congress an intent that the members of that Congress did not themselves state. It is for this reason that the Supreme Court has consistently and unequivocally concluded that:
>
> > '[T]he views of a subsequent Congress form a hazardous basis for inferring the intent of an earlier one.'
>
> "*United States* v. *Price,* 361 U.S. 304, 313 (1960); *accord, United States* v. *Southwestern Cable Co.,* 392 U.S. 157, 170 (1968); *United States* v. *Philadelphia National Bank,* 374 U.S. 321, 348-49 (1963); *Rainwater* v. *United States,* 356 U.S. 590 (1958); *United States* v. *United Mine Workers,* 330 U.S. 258, 281-82 (1947). In response to an argument remarkably similar to that made here by the PTO, the Supreme Court, in *Rainwater* v. *United States, supra,* 356 U.S. at 593, rejected an invitation to interpret the meaning of an act of Congress by reliance on a later amending act with the following comment:
>
> > 'At most, the * * * amendment is merely an expression of how * * * [a later] Congress interpreted a statute passed by another Congress more than half a century before. Under these circumstances such interpretation has very little, if any, significance.'" (P. App. A 51a).

The *Bergy* majority found that the purpose of Congress in enacting the Plant Patent Act ". . . was precisely what Congress said it was—to offer to the useful art of *plant breeding* in the fields of horticulture and agriculture the benefits of the patent system that had theretofore been available only to industry." (P. App. A 59a).

CONCLUSION

The above clearly shows that there are *no special* and *important* reasons for granting a writ of certiorari in this case. The raising of emotional points by Petitioner does *not* make the case special or important. Emotional exhortations bottomed upon sheer speculation of future legal problems, and an apparent lack of understanding of the true benefits and risks of microbiological inventions, cannot be relied upon as a guiding force in the administration of the Patent Law.

The *Bergy* majority has resolved the issue in a way which benefits the public and the inventor, a solution which is completely in accord with the Patent Law. There is clearly no basis or need to review the issue further.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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